

10/105,693

REMARKS:

Claims 1-121 are pending in this application.

Claims 1-21 stand rejected.

Claims 1 and 9 been amended to more particularly point out a key feature of the invention – that the erodable triarylsilyl(meth)acrylol polymer binder is a terpolymer – having an A component and at least two different B components.

35 U.S.C. §103(a)

Claims 1-stand rejected under 35 U.S.C. §103(a) as being unpatentable over Gitlitz et al, U.S. Patent Number 4,593,055. The Gitlitz reference fails to teach or suggest every claim limitation of Applicant's claims as amended, and therefore fails to present a *prima facie* case of obviousness. Specifically, the '055 reference fails to teach or suggest that a terpolymer containing 9 to about 20 mole percent of triarylsilyl(meth)acrylol groups can be used in a marine antifouling paint and have an erosion rate in seawater of from 2 to 15 microns per month.

The '055 patent mentions in column 4, lines 9 and 10 that the polymer binder may be made from "one or more copolymerizable ethylenically unsaturated monomers, however fails to exemplify, or describe any advantages of a terpolymer over a copolymer. Instead, the '055 reference teaches away from Applicant's claims, and any advantage of a terpolymer by describing and exemplifying only copolymers. Applicant has found that the use of two or more "B" monomer units of the polymer resulted in an improvement in properties. One would not be able to arrive at Applicant's claims by routine experimentation, based on the '055 reference, as using more than one type of non-silyl acrylate, in a marine antifoulant coating was not recognized as a result-effective variable, and thus cannot be optimized.

While it holds no value in the USPTO, the European Examiner in the equivalent case has found the terpolymer claimed by Applicant to be both novel and possessing an inventive step.

In view of the above, the Applicant believes that the reasons for rejection have been overcome, and the claims, as amended herein, should be allowable to the Applicant. Accordingly, reconsideration and allowance are requested.

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Double Patenting

Claims 1-21 stand provisionally rejected on the grounds of nonstatutory double patenting over claims 1-17 of copending Application No 10/442,461.

Applicant disagrees that a double patenting rejection should apply, as the limitation to a terpolymer is not claimed in copending Application No 10/442,461.

However, if both applications are allowed, Applicant would agree to file a Terminal disclaimer in the present case.

Respectfully submitted,



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Date: 8/4/06

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